

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Karl-Heinz Kogel et al.

Application No.: 10/522,106

Confirmation No.: 9243

Filed: January 24, 2005

Art Unit: 1638

For: METHOD FOR OBTAINING THE
PATHOGENIC RESISTANCE IN PLANTS

Examiner: Ibrahim, Medina Ahmed

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the restriction requirement set forth in the Office Action mailed May 28, 2009, Applicants provisionally elect Group I, claims 1-23 and SEQ ID NO: 2, with traverse. Applicants thank the Examiner for acknowledging that claims 1 and 2 are generic claims, and for subjecting the restriction requirement between the sequences to the non-allowance of claims 1 and 2. Applicants respectfully traverse and strongly urge reconsideration and withdrawal of the restriction requirement for the following reasons.

Because this application is a national stage filing pursuant to 35 U.S.C. § 371, unity of invention under PCT Rule 13.1 and 13.2 is the applicable standard. It is respectfully submitted that a requirement for an election based on the species recited in a dependent claim is improper under PCT Rules which govern in a national stage application. See Chapter 10 §10.06, PCT International Search and Preliminary Examination Guidelines (Unity of invention must be “considered in the first place only in relation to the independent claims” and not the dependent claims (emphasis added)). Furthermore, Chapter 10 §10.07 of the Guidelines states the “[i]f the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention.” The methods listed by the Examiner in Groups I-V correspond to the species recited in dependent claim 4 and as such cannot be the basis for a finding of lack of unity.